

Remarks

Upon entry of this amendment, claims 97-98 and 103-110 are pending. Claim 104 has been amended, and claims 109-110 have been added by this amendment.

Amendments to the Claims

Claim 104 has been amended, as discussed below, in accordance with the suggestions of the Examiner in the Office action dated January 17, 2007, to eliminate the "consisting essentially of" verbiage and the specific composition ratios, suggested as being not in compliance with 35 U.S.C. 112, first paragraph. As pointed out by the Examiner (see paragraph 2), there is no dispute that the specification, at least at paragraphs 9, 11, 24, 46, 48, 51, 60 and 61, supports the general composition of claim 104, as now amended.

New Claims

New claims 109 and 110 have been added to present the subject matter of original claims 56 and 57, thus placing the application in better form for consideration on appeal, should the present final rejection be maintained.

Rejections under 35 U.S.C. § 112

Claims 97-98 and 103-104 remain rejected under 35 U.S.C. § 112 first paragraph, as failing to satisfy the written description requirement. Applicant respectfully traverses and, for the following reasons, requests reconsideration and withdrawal of this rejection to the pending claims as amended.

To comply with the written description requirement, "the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question." *Fujikawa v. Wattanasin*, 93 F.3d 1559 (Fed. Cir. 1996) at p. 1570. Finding the same wording (*ipsis verbis*) used in the claim is not necessary. *Id.* Thus, so long as a person "of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if

every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met." *In re Alton*, 76 F.3d 1168 (Fed. Cir. 1996) at p. 1175. " . . . [H]ow the specification accomplishes this is not material." *Id.* At p. 1172 (citing *In re Wertheim*, 541 F.2d 257, 262 (C.C.P.A. 1976).

Claim 104, as amended-the principal independent claim- relates to a composition for promoting the growth and strengthening of bone comprising a mixture of hyaluronic acid/salt thereof, cancellous bone, demineralized bone matrix (DBM), and non-decalcified bone matrix (NBm). Applicant is entitled to the entry of said amendment, after final, pursuant to 35 CFR Sec. 1.116 : (1) "An amendment may be made . . . complying with any requirement of form expressly set forth in a previous Office action"; and/or (2) "An amendment presenting rejected claims in better form for consideration on appeal may be admitted."

While applicant disagrees with the rationale for the prior traversal, applicant urges that the present amendment to claim 104 directly addresses the new matter rejection lodged at paragraph (2) of the Office action pursuant to the Examiner's prior requirement of form. As therein stated at paragraph (2), "While the specification . . . supports the general composition of claim 104, the specific composition limited by the consisting essentially of now recited in claim 104 is not envisioned. The specific composition having the specific ranges as stated in the claims additionally with the consisting essentially of was not envisioned at filing. . . . Applicant may overcome this rejection by amending the claims to be commensurate with the composition disclosed in the specification." (Emphasis added.)

Accordingly, pursuant to the Examiner's prior statement at paragraph 2 of the January 17, 2007, Office action, applicant seeks to expedite prosecution and allowance by complying with the above suggestion as to form, and has substituted "comprising" for "consisting essentially of" and has removed the objected to ranges from claim 104. Hence, pursuant to 35 CFR Sec. 1.116(1), the amendment to claim 104 should be entered, and the rejection based on 35 U.S.C. 112, first paragraph withdrawn.

In the alternative, the amendment to claim 104 places the claims in better form for consideration on appeal, and should be admitted on that basis.

Applicants note that a Notice of Allowance was originally entered in this application on May 24, 2006, after amendments were made pursuant to an Examiner's interview. New claims 109 and 110 re-present original claims 56 and 57 (57 as limited to the use of the composition of claim 56 for inducing bone formation). These original claims clearly overcome any asserted new matter rejection. As amendments were made to expedite prosecution, although prior grounds for rejection had been traversed, applicant requests that claims 109 and 110 be entered to present the original claims for consideration on appeal, pursuant to 37 CFR 1.116(2). Accordingly, adequate written description having been demonstrated for amended claim 104 and the remaining claims, applicant urges that the rejection under 35 U.S.C. § 112, ¶1 be withdrawn and the claims allowed to issue without delay. Alternatively, applicant urges that the amendments be entered pursuant to the provisions of 37 CFR 1.116(1) and (2), for consideration on appeal.

Conclusion

Applicant respectfully requests withdrawal of the rejections and believes that the claims as presented represent allowable subject matter. If the Examiner desires, applicant welcomes a telephone interview to expedite prosecution and is available at the telephone number below. Applicant believes there is no fee due at this time. However, the Commissioner is hereby authorized to deduct any deficiency or credit any overpayment to Deposit Account No. 19-3140.

Dated: 3-19-07

Respectfully submitted,



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